

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1, 2, and 5-14 are currently pending in this application. Claim 1 is independent. The remaining claims depend, directly or indirectly, from claim 1.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 5, and 9-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,870,474 (“Wasilewski”) in view of U.S. Patent No. 6,771,657 (“Elstermann”). This rejection is respectfully traversed.

Applicant respectfully asserts that Elstermann does not qualify as prior art under 35 U.S.C. § 102, and thus cannot be used in a rejection under § 103. Specifically, as the Examiner has acknowledged, the present application claims foreign priority to European Patent EP97403150.2, filed on December 23, 1997. Thus, any cited prior art must have an effective 35 U.S.C. § 102 a, b, or e date that is *before* 12/23/97. Elstermann was filed on October 11, 2000, and claims domestic priority via a provisional application to December 9, 1999. Thus, the earliest effective date for Elstermann (under § 102(e)) is December 9, 1999. Because Elstermann’s § 102(e) date is *after* the foreign priority date of the present application, Elstermann does not qualify as prior art under § 102.

In view of the above, claims 1, 2, 5, and 9-14 are patentable over Wasilewski and Elstermann. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wasilewski and Elstermann, and further in view of U.S. Patent No. 5,566,174 (“Sato”). This rejection is respectfully traversed.

As described above, Elstermann is improper prior art. Further, Wasilewski and Sato fail to render the claimed invention obvious. Specifically, the Examiner admits that Wasilewski fails disclose or suggest inserting a packet of data in the transport stream by detecting the presence of a null packet and placing a null packet by the packet to be inserted (*see* Office Action mailed February 10, 2006, page 3). Further, Sato fails to provide that which Wasilewski lacks, as evidenced by the fact that the Examiner relies on Sato solely for the purpose of disclosing packet deletion means by transforming the packet ID of the packet to that of a null packet (*see* Office Action mailed February 10, 2006, page 5). In view of the above, it is clear that independent claim 1 is patentable over Wasilewski and Sato, whether considered separately or in combination. Further, dependent claims 6 and 7 are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wasilewski and Elstermann, and further in view of U.S. Patent No. 5,640,388 (“Woodhead”). This rejection is respectfully traversed.

As described above, Elstermann is improper prior art. Further, Wasilewski and Woodhead fail to render the claimed invention obvious. Specifically, the Examiner admits that Wasilewski fails disclose or suggest inserting a packet of data in the transport stream by detecting the presence of a null packet and placing a null packet by the packet to be inserted (*see* Office Action mailed February 10, 2006, page 3). Further, Woodhead fails to provide that which Wasilewski lacks, as evidenced by the fact that the Examiner relies on Woodhead solely for the


purpose of disclosing packet counting means for counting the number of packets of a predetermined packet ID value in the received transport data stream (*see* Office Action mailed February 10, 2006, page 6). In view of the above, it is clear that independent claim 1 is patentable over Wasilewski and Woodhead, whether considered separately or in combination. Further, dependent claim 8 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345/015001).

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Respectfully submitted,

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